

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 30 and 40 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-48 are now pending in this application.

In the September 19, 2008 Office Action, the Examiner continued to reject claims 1-48 under 35 U.S.C. §102(b) based upon U.S. Publication No. 2002/0041291 (Vale). In these rejections, the Examiner has taken the position that Vale teaches all of the features of the pending claims, even in view of the amendments made by Applicant in its August 4, 2008 Amendment and Reply. For the following reasons, Applicant respectfully traverses these rejections.

In its August 4, 2008 Amendment and Reply, Applicant amended the independent claims of the present application to more particularly describe how a determination is made, in response to the opening of a file list by a user, as to whether there was a file previously selected by the user from the file list before the opening of the file list.¹ If a file was previously selected by the user from the file list before the opening of the file list, then an automatic determination is made as to whether there is a “next file” listed in relation to the previously selected file and, if so, this next file is automatically highlighted for the user. As was discussed at length in Applicant’s August 4, 2008 Amendment and Reply, several of these features are missing from Vale. Each of these features is discussed individually below.

¹ In order to correct inconsistencies between the independent claims, Applicant has amended claims 30 and 40 to more closely track the language of claims 1 and 20.

“Determining if there was a file previously selected by the user from the file list before the opening of the file list.”

First, Applicant disputes the Examiner’s contention that Vale teaches “determining if there was a file previously selected by the user from the file list before the opening of the file list.” In fact, Vale makes no mention of making any determinations whatsoever based on what occurred *before* a particular file list was opened. Instead, Vale only discusses various processes which may occur after a navigation or edit mode has been entered into, i.e., after a file list has already been opened. For example, paragraphs [0040] and [0041] discuss how individual files may be selected based upon the use of a direction input when navigating through a list, inherently requiring that the list already be open when the direction input is actuated. Other sections of Vale also reference processes that occur after a list has been opened. In none of these locations, however, is there any discussion of making any determinations based upon what occurred *before* a list was opened.

In arguing that Vale teaches the feature of “determining if there was a file previously selected by the user from the file list before the opening of the file list,” the Examiner asserted that paragraph [0049] disclosed this feature. In particular, the Examiner quoted specific text from this paragraph, noting:

Depending on the selected interactive element, input received while in edit mode may be used by the interactive element (e.g., entering characters into a textbox) or may cause a return to navigation mode (e.g., so that another interactive element may be selected).

However, and as one skilled in the art would readily recognize, the above text does not teach “determining if there was a file previously selected by the user from the file list before the opening of the file list.” Instead, this only notes that a navigation mode may be entered in response to an input. Even if, for argument’s sake, the entering of the navigation mode is equivalent to the opening of a file list, the above section still makes no mention of, once in navigation mode, whether a determination about whether a file was previously selected before the list was opened. This is particularly true when the immediately preceding limitation of the pending claims is considered, namely the phrase “in response to an opening of a file list by the user.” In other words, in order to meet this limitation in the pending

independent claims, a determination of whether a file was selected before the file list was opened must occur after the opening of the file list. However, with no discussion of this determination being made after the navigation mode has been entered into, the entirety of this limitation cannot be met by paragraph [0049] of Vale.

“If it is determined that there was a file previously selected by the user from the file list before the opening of the file list.”

For substantially the same reasons as those discussed above, Applicant also disagrees with the position that Vale teaches or suggests “if it is determined that there was a file previously selected by the user from the file list before the opening of the file list.” In particular, Applicant reiterates that Vale does not teach making any determinations based on what occurred before a particular file list was opened, much less the specific determination of whether a file was previously selected by the user before the file list was opened. Once again, the Examiner asserted that paragraph [0049] taught this particular feature. As noted above, however, neither the cited portion of paragraph [0049] nor any other portion of this paragraph mentions a determination of whether a file was previously selected before a file list was opened, and particularly with this determination being made in response to the file list being opened. For this reason, to the extent that Applicant argued above that Vale fails to teach “determining if there was a file previously selected by the user from the file list before the opening of the file list,” these arguments also apply to the feature of “if it is determined that there was a file previously selected by the user from the file list before the opening of the file list,” and these arguments are incorporated herein by reference in their entirety.

“Automatically determining if there is a next file listed relative to the previously selected file in the file list”

Applicant also disputes the Examiner’s contention that Vale teaches the feature of “automatically determining if there is a next file listed relative to the previously selected file in the file list.” With regard to this particular limitation, the Examiner is directed that this automatic determination of a next file is based upon “*the* previously selected file” and not “a previously selected file.” By using the term “the” instead of “a,” Applicant is clearly referring to the “file previously selected by the user from the list before the opening of the file list” mentioned in the immediately preceding phrase. As such, the limitation

“automatically determining if there is a next file listed relative to the previously selected file in the file list” cannot be met unless it is clear that, in the prior art, the “previously selected file” was selected before the file list was opened.

In the above context, it is clear that Vale does not teach or otherwise disclose this particular limitation. Instead, Vale describes a system and method for browsing content using a particular navigation mode, with the navigation mode explicitly involving the use of a direction key by the user. It is only in response to an actuation of this direction key that a determination of whether there is a “next” file exists is made. This point is made clearly, for example, in paragraph [0010] of Vale, where it is stated:

In navigation mode, pressing a direction key selects the next interactive element in the direction indicated by the direction key (e.g., up, down, left, right). When moving horizontally, an interactive element is in the direction indicated by the direction control if the interactive element is at substantially the same vertical level. For example, if a later element overlaps a previous element on a given vertical level by any amount, the two elements are considered to be at substantially the same vertical level. Vertical movement is to an interactive element at the next vertical level in the direction indicated by the direction control. If multiple interactive elements lie at the next vertical level, the one closest in the horizontal direction to the beginning of the current interactive element is selected. (emphasis added).

This feature is also described at paragraph [0040] of Vale, where it is explicitly noted that the operation of the navigation mode involves the receipt of a direction input 320. Continuing to paragraph [0041], it is noted that the selection of the next interactive element (and therefore the determination of the next interactive element” is dependent upon the direction of the direction input 320, e.g., how the four-direction and action key 210 is manipulated. In each case, however, there is no discussion of this “previously selected” interactive element having been selected before the list of interactive elements was opened.

In asserting that the feature of “automatically determining if there is a next file listed relative to the previously selected file in the file list” is present in Vale, the Examiner referred specifically to the following text paragraph [0058] of this reference:

an act of scrolling (936a) the display of the content in the direction of the received direction input if less than all of the content is displayed and no interactive element is at least partially visible; and an act of selecting (938a) an interactive element based on the received direction input relative to a previously selected interactive element or, if no interactive element has been previously selected, based on the direction input relative to the beginning of the displayed content.

In the above section, the Examiner particularly relied upon the phrase “if no interactive element has been previously selected” to support his position. However, neither this specific phrase, the above section, nor any other portion of paragraph [0058] refers to a previous file which was selected before the file list was opened. Instead, the relevant portion of paragraph [0058] refers to two specific scenarios—one where a file was selected just before a directional input was actuated and another where no file was previously selected. In the former case, it is clear that the “previously selected interactive element” is the element which was selected immediately before the scrolling command, meaning that the determination of the “next” file is not relative to a file that was selected before the list was opened. In the latter case (which was specifically relied upon by the Examiner), this text cannot satisfy the limitation at issue since there was no previously selected file in the first place! In other words, by acknowledging that there was no previously selected file to begin with, it is not possible for this section to teach making a determination based upon this nonexistent previously selected file.

For the above reasons, Applicant submits that neither the text relied upon by the Examiner nor any other portion of Vale teaches “automatically determining if there is a next file listed relative to the previously selected file in the file list.”

“If it is determined that there is a next file listed relative to the previously selected file in the file list, automatically displaying the file list with the next file highlighted.”

Furthermore, Applicant also disputes the Examiner’s position that Vale teaches or suggests the limitation “if it is determined that there is a next file listed relative to the previously selected file in the file list, automatically displaying the file list with the next file highlighted.” Once again, Applicant respectfully notes that the “automatically displaying the file list with the next file highlighted” only occurs if it has first been determined that there is

a “next” file listed relative to the previously selected file and, as discussed above, this “previously selected file” must have been previously selected before the file was opened. If the previous file was selected after the file was opened, then it is not possible for the first half of the limitation at issue (“if it is determined that there is a next file listed relative to the previously selected file in the file list”) to be met, in which case the automatic displaying of the file list with the next file highlighted does not follow.

In view of the above, Vale does not teach or suggest a system that can implement this limitation. As has been discussed both in the present response and in previous responses, Vale teaches a system and method by which a direction key is used to highlight individual items in order, where highlighting moves from a first interactive element to a second interactive element in response to the user actuating a direction key. In the implementations of Vale, however, all of these actions occur in response to the user actuating the direction key relative to an element that has already been highlighted. In fact, there is not a single example in Vale of a situation where a “next” interactive element is highlighted based upon the fact that a different interactive element was selected before the file or element list was opened. Without any clear teaching that a previous interactive element was selected before the file list was opened, it is improper for the Examiner to assert that Vale teaches this feature.

In responding to Applicant’s previous arguments, the Examiner referred specifically to paragraph [0065] of Vale and, more specifically, to the following text in paragraph [0065] of Vale:

A step for indicating (940c) that an interactive element is selected may further include the acts of removing (942) the highlighting from a previously selected interactive element and highlighting (944c) the next selected interactive element (*see also* 940a of FIG. 9A)...

Although the above text may refer to the automatic highlighting of a “next” interactive element, this section is silent as to *when* the “previously selected interactive element” was previously selected. In fact, if one reviews all of the text associated with FIG. 9A of Vale, *i.e.*, paragraph [0058]–[0059] and [0064]–[0065], one will quickly observe that there is no discussion in any of these sections of an interactive element being selected *before*

the list at issue was opened. Without such a reference, it cannot be asserted that Vale also teaches the highlighting of a next file relative to a file which was selected before the file was opened.

Conclusion

In summary, Applicant submits that Vale fails to teach “determining if there was a file previously selected by the User from the file list before the opening of the file list.” Without a teaching of this feature, it is likewise not possible for Vale to teach any of the elements which are based off of this determination, namely, automatically determining if there is a next file listed relative to the previously selected file in the file list, and if so, automatically displaying the file list with the next file highlighted. For this reason, unless the Examiner can point, with particularity, to a location within Vale where a determination is made that a file was previously selected by the user before the file list was opened, the Examiner’s rejection of Claims 1-48 based upon Vale cannot stand.

For the above reason, Applicant respectfully submits that the Examiner’s rejection of Claims 1-48 under 35 U.S.C. § 102(b) based upon Vale are improper and should be withdrawn.

Lastly, Applicant acknowledges that the Examiner has issued several Office Actions relying specifically upon Vale, and Applicant has now filed several responses explaining the differences between Vale and the pending claims. In the interest of advancing the prosecution of the present application, Applicant would like to invite the Examiner to contact the undersigned if he feels that another Office Action is warranted. In particular, Applicant requests that the Examiner contact the undersigned *before a new Office Action is issued* so that the Examiner and Applicant can discuss potential claim language which may address the Examiner’s ongoing concerns.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: December 11, 2008

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